

II. REMARKS

Preliminary Remarks:

Upon entry of this amendment, claims 1, 3-5, and 7-22 will be pending of which claims 1, 15, 21, and 22 are independent. Claims 1, 5, 7, 8, 15, 21, and 22 are amended; claims 2 and 6 are canceled. Support for the claim amendments can be found in the claims and specification as filed (see, for example, page 3, line 5-16). Therefore, the applicants believe that no new matter has been added as a result of these amendments.

Claim 7 was objected to for containing the term "synthetic rubber". This term is deleted rendering this objection moot. Claim 8 is similarly amended.

The applicants respectfully request reconsideration and allowance of the present application. This amendment is filed within the statutory period for response along with the fee for a one-month extension of time.

Patentability Remarks:

Rejections under 35 U.S.C. §102(b) –

Claims 1-3, 9, 11, 12, 14, 15, 18, and 19 were rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Scholl *et al.* (U.S. Pat. No. 5,650,457). This rejection is moot in view of the amendments to the claims.

Claim 2 is canceled. As amended, claims 1, 3, 9, 11, 12, 14, 15, 18, and 19 are directed to, *inter alia*, a rubber mixture in which R⁴ is a linear or branched (C₃-C₁₈) divalent hydrocarbon group. In contrast in Scholl *et al.*, the linker between the Si and S atoms (equivalent to R⁴ in the present application) can only be CH₂. Therefore, the pending claims are not anticipated by Scholl *et al.* and the applicants respectfully request removal of this rejection.

Claims 1-5, 9-15, and 18-22 were rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Zimmer *et al.* (EP 0 732 362). This rejection is moot in view of the amendments to the claims.

Claims 2 is canceled. As amended, claims 1, 3-5, 9-15, and 18-22 are directed to, *inter alia*, a rubber mixture in which R¹ = ethoxy, R² = R³ = methyl. In contest, Zimmer *et al.* does not describe any ethoxy, dimethyl compounds. Therefore, the pending claims are not anticipated by Zimmer *et al.* and the applicants respectfully request removal of this rejection.

Inventor(s): LUGINSLAND
Application No.: 09/538,941
Attorney Docket No.: 021123-0258030

Claims 1, 9, 11-15, and 18-20 were rejected under 35 U.S.C. §102(a) as allegedly being anticipated by Ohta *et al.* (U.S. Pat. No. 6,489,389). This rejection is moot in view of the amendments to the claims.

As amended, claims 1, 9, 11-15, and 18-20 are directed to, *inter alia*, a rubber mixture in which R¹ = ethoxy, R² = R³ = methyl. In contrast, Ohta *et al.* does not describe any ethoxy, dimethyl compounds. Therefore, the pending claims are not anticipated by Ohta *et al.* and the applicants respectfully request removal of this rejection.

Rejections under 35 U.S.C. §103(a) –

Claims 1-12, 14-19, 21, and 22 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Wolff *et al.* (U.S. Pat. No. 5,159,009) in view of Scholl *et al.* This rejection is moot in view of the amendments to the claims.

Claims 2 and 6 are canceled. As amended, claims 1, 3-5, and 7-12, 14-19, 21, and 22 are directed to, *inter alia*, a rubber mixture in which R¹ = ethoxy, R² = R³ = methyl, and R⁴ is a linear or branched (C₃-C₁₈) divalent hydrocarbon group. As noted earlier, in Scholl *et al.*, R⁴ can only be CH₂. All the compounds in Wolff *et al.* have three alkoxy groups. Therefore, the combination of Wolff *et al.* and Scholl *et al.* does not teach or suggest all the claim limitations.

The applicants respectfully submit that this application is in condition for allowance and respectfully request a timely Notice to that effect. Should questions relating to patentability remain, the examiner is invited to contact the undersigned to discuss the same.

Respectfully submitted,

PILLSBURY WINTHROP LLP

By: 

Thomas A. Cawley, Jr., Ph.D.
Registration No.: 40,944
Direct Telephone No.: 703-905-2144

TAC\GP

P.O. Box – 10500
McLean, VA 22102

General Telephone No.: 703-905-2000
General Facsimile No.: 703-905-2500